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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/007,902	11/08/2001	Michael J. Beaver	10790-006001	3092
26191	7590	06/06/2005	EXAMINER	
FISH & RICHARDSON P.C. PO BOX 1022 MINNEAPOLIS, MN 55440-1022				WEIER, ANTHONY J
ART UNIT		PAPER NUMBER		
		1761		

DATE MAILED: 06/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.	10/007,902	Applicant(s)	BEAVER ET AL
Examiner	Anthony Weier	Art Unit	1761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1) Responsive to communication(s) filed on 28 February 2005.  
2a) This action is FINAL.      2b) This action is non-final.  
3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

4) Claim(s) 1-10 and 12-44 is/are pending in the application.  
4a) Of the above claim(s) 1-9,37-39 and 41-44 is/are withdrawn from consideration.  
5) Claim(s) \_\_\_\_\_ is/are allowed.  
6) Claim(s) 10,12-36 and 40 is/are rejected.  
7) Claim(s) \_\_\_\_\_ is/are objected to.  
8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

9) The specification is objected to by the Examiner.  
10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All    b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

1) Notice of References Cited (PTO-892)  
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) Notice of Informal Patent Application (PTO-152)  
6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

1. Claim 40 is rejected under 35 U.S.C. 102(b) as being anticipated by Japan 11-196803.

The claims stand rejected for the reasons set forth in the last Office Action (mailed 11/2/04).

### ***Claim Rejections - 35 USC § 103***

2. Claims 10 and 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 96/10341 taken together with Applicants' own admission.

The claims stand rejected for the reasons set forth in the last Office Action (mailed 11/2/04, see paragraphs 6 and 7).

3. Claims 16, 17, 19/16, 20-24, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicants' own admission taken together with Kim et al.

The claims stand rejected for the reasons set forth in the last Office Action (mailed 11/2/04).

4. Claims 18, 19/18, 27, 29-32, and 34-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicants' own admission taken together with Kim et al (as applied above) and further in view of Uesugi et al.

The claims stand rejected for the reasons set forth in the last Office Action (mailed 11/2/04).

5. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Applicants' own admission taken together with Kim et al (as applied in paragraph 3 above) and further in view of Strop.

The claims stand rejected for the reasons set forth in the last Office Action (mailed 11/2/04).

6. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Applicants' own admission taken together with Kim et al and Uesugi et al (as applied in paragraph 4 above) and further in view of Strop.

The claims stand rejected for the reasons set forth in the last Office Action (mailed 11/2/04).

7. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Applicants' own admission taken together with Kim et al and Uesugi et al (as applied in paragraph 4 above) and further in view of WO 96/10341.

The claims stand rejected for the reasons set forth in the last Office Action (mailed 11/2/04).

#### ***Response to Arguments***

8. Applicant's arguments filed 2/28/05 have been fully considered but they are not persuasive.

Applicants argue that JP 11-196803 (i.e. Kim, U.S. Patent No. 5,952,230) employs gravity separation to remove embryos from the hull and any remaining meat particles rather than size separation. Kim, however, does set forth size separating of material by using sieving/sifting steps. In particular, the germs are removed from the

hulls using sieving/sifting steps. It is considered inherent, however, that residual soybean meat would also be present and subjected to the same sieving/sifting steps; instant claim 40 broadly encompass any amount of soybean meat and do not exclude small residual amounts.

Applicants argue that WO 96/10341 does not disclose or teach cracking whole soybeans to produce a cracked soybean stream having a cracked size such that about 50% of the cracked particles are larger than 3.35 mm. It should be noted, however, that after cracking of the soybeans (which whole are all at least 6 mm; see Example 1, prescreening step), material removed through a sieving machine having apertures of as high as 2 mm. In other words, everything greater than 2 mm would be retained. WO 96/10341 further discloses that the seeds are broken into 2 to 20 pieces per seed. In the event that seeds are only cracked into two portions per seed and since hypocotyls material is such a small portion of seed, it is likely that the vast majority of the broken seed would be retained and that what is left would be at least 4 mm in size (since the screen apertures are as high as 2 mm and the size of the whole soybeans to begin are at least 6 mm). Nevertheless, WO 96/10341 discloses the step of cracking and subsequent separation of germ containing material, and, absent a showing of unexpected results, the particular cracked size and amounts of same are result effective variables would have been obvious to one skilled in the art at the time of the invention to have arrived at through routine experimental optimization.

Applicants argue that there is no motivation to combine Kim et al with Applicant's own admission. Examiner disagrees. It would have been obvious to one having

ordinary skill in the art at the time of the invention to have incorporated the separation of the embryo as taught by Kim et al in the process of Applicants' own admission for the benefits attributed to the embryo portion of the soybean (see Kim et al, col. 1, lines 36-55). It would have been well within the purview of a skilled artisan at the time of the invention to have incorporated such step in the processing line described via Applicant's own admission.

Applicants argue that the applied references do not teach a second cracking step. However, this limitation was addressed in view of the teachings of Uesugi et al as applied in the last Office Action.

All other arguments have been addressed in view of the rejections as set forth above.

***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

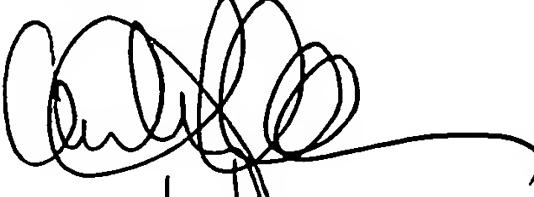
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Weier whose telephone number is 571-272-1409. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Anthony Weier  
Primary Examiner  
Art Unit 1761

Anthony Weier  
May 27, 2005



S 27 05

A handwritten signature of "Anthony Weier" is written in cursive across the top of a vertical line. Below the signature, the date "May 27, 2005" is handwritten vertically along the same line.